

*Filed Electronically*

PATENT APPLICATION  
Docket No. 15436.299

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of		)
		)
	Stephen Hosking	)
		)
Serial No.:	10/784,565	) Art Unit
		) 2828
Filed:	February 23, 2004	)
		)
For:	SYSTEM AND METHOD FOR CONTROL	)
	OF OPTICAL TRANSMITTER	)
		)
Confirmation No.:	8644	)
		)
Customer No.:	022913	)
		)
Examiner:	Armando Rodriguez	)

PETITION UNDER 37 C.F.R. § 1.144  
TO REVIEW A RESTRICTION REQUIREMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.144, Applicant hereby petitions the Director to review the final restriction requirement made by the Examiner in the second Office Action mailed January 26, 2007 (the “second Office Action”). Applicant has traversed the restriction requirement and accordingly requested reconsideration to properly preserve the right to petition. Consequently, this petition sets forth the relevant facts establishing the impropriety of the final restriction requirement.

### **STATEMENT OF THE FACTS**

The first Office Action, mailed October 10, 2006 (the “first Office Action”), set forth a restriction requirement that characterized four (4) patentably distinct species of the claimed invention. In particular, the Examiner stated that the present application contains claims directed to the following species:

Species I: Claims 1, 2, 4, 6, and 8 pertains to implementing the control of the bias and modulation at different times and claims 6, 8 and 7, 9 mutually exclude each other;

Species II: Claims 1, 3, 7, and 9 pertains to implementing the control of the bias and modulation at the same time;

Species III: Claims 1, 5, 7, and 9 pertains to implementing the control of the bias and modulation at different times; and

Species IV: Claims 15-22, pertains to controlling the bias and modulation at first and second time slots.

The Examiner also stated that claim 1 is generic to all of the aforementioned species. Furthermore, the Examiner alleged that the species are independent or distinct because they are mutually exclusive.

In response to the first Office Action, Applicant elected Species I for examination, with traverse. With regard to the traversal, Applicant argued that the restriction requirement was problematic for a variety of reasons explained in the arguments below.

In the second Office Action, the Examiner acknowledged the Applicant’s election with traverse of Species I. However, the Examiner found the traversal unpersuasive because “in species I ...the bias is implemented prior to the modulation and in species III ...the modulation is implemented prior to the bias, therefore the species I and III are mutually exclusive.” *Second Office Action at 2*. Moreover, the Examiner stated that Applicant’s arguments regarding claims 6, 7, 8 and 9 were “not understood.” *Second Office Action at 2*. The Examiner also claimed to be “unable to find in the [first] office action ... where claims 6, 7, 8 and 9 are described as implementing bias and modulation at different times.” *Second Office Action at 2*. Consequently, the Examiner made the restriction requirement final, resulting in the withdrawal of claims 3, 5, 7 and 9-22.

In view of the foregoing, Applicant respectfully requests that this Petition to Review a Restriction Requirement be satisfied by withdrawal of the initial restriction requirement, or at the

very least, a new restriction requirement encompassing two new species, namely Species IA (claims 1, 2, 4-9, and 15-22) and Species IIA (claims 1 and 3).

### ARGUMENTS

The Applicant respectfully requests that the restriction requirement be withdrawn as the Examiner's restriction requirement is overly restrictive, based on contradictory rationale, and incomplete as originally presented, as the following arguments illustrate.

While the Examiner incorrectly stated in the first Office Action that claims 6 and 8 of Species I and claims 7 and 9 of Species III "mutually exclude each other," the Examiner has nonetheless characterized both Species I and III as pertaining to the same notion, namely, "implementing the control of the bias and modulation at different times." *First Office Action at 2*. This characterization contradicts the judgment of the Examiner that claims 1, 2, 4, 6 and 8 should be assigned to one species (namely, Species I), while claims 1, 5, 7 and 9 should be assigned to another species (namely, Species III).

In addition, the Examiner has characterized each of claims 7 and 9 in two contradictory fashions. Particularly, the Examiner asserted on the one hand that "Species II, claims ... 7, 9, pertains to implementing the control of the bias and modulation at the same time." *First Office Action at 2 (emphasis added)*. On the other hand, however, the Examiner simultaneously asserted that "Species III, claims ... 7, 9, pertains to implementing the control of the bias and modulation at different times." *First Office Action at 2 (emphasis added)*. This contradictory characterization indicates the impropriety of the Examiner's classification of claims 7 and 9 as belonging to separate and distinct species.

Furthermore, the Examiner has erred in suggesting that claims 6, 7, 8 and 9 pertain to "implementing the control of the bias and modulation at different times." *First Office Action at 2 (emphasis added)*. In fact, none of claims 6-9, each of which depends directly from generic claim 1, makes any reference to the relative times at which either a laser bias control scheme or electrical modulation amplitude control scheme is implemented. Rather, claims 6-9 refer to the manner of change, either linearly or non-linearly, in which either a laser bias control scheme or electrical modulation amplitude control scheme is implemented. Therefore, claims 6-9 are more appropriately classified as generic because they do not relate to the Examiner's basis for the restriction requirement, namely that change of the laser bias and the electrical modulation amplitude occurs at either the same or different times.

Moreover, in response to the Applicant's traversal, the Examiner presented a new argument that was not previously introduced to support the restriction requirement between

Species I and III. The Examiner stated that “in species I ...the bias is implemented prior to the modulation and in species III ...the modulation is implemented prior to the bias, therefore the species I and III are mutually exclusive.” *Second Office Action at 2*. This justification for the restriction requirement was not presented when the Examiner initially imposed the restriction requirement on the Applicant, nevertheless, the Examiner relied on this argument to make the restriction requirement final. Consequently, the Applicant was never afforded an opportunity to respond to this new basis for imposing the restriction requirement. In addition, the Examiner’s characterization of Species I and III is inaccurate, as claim 2 of Species I refers to changing at least a portion of the modulation at a different time than the bias and claim 3 of Species III refers to changing the modulation and bias at substantially the same time. The use of the terms “at least a portion” in claim 2 and “substantially” in claim 3, qualify the claims of Species I and III such that those claims are not strictly mutually exclusive as the Examiner contends. Therefore, the Examiner’s contention that Species I and III are mutually exclusive is not entirely accurate, thereby establishing the impropriety of the restriction requirement.

Lastly, in the second Office Action the Examiner claims to be “unable to find in the [first] office action ... where claims 6, 7, 8 and 9 are described as implementing bias and modulation at different times.” *Second Office Action at 2 (emphasis added)*. However, in the first Office Action, the Examiner clearly stated that Species I claims 6 and 8 pertain “to implementing the ... bias and modulation at different times” and similarly, Species III claims 7 and 9 pertain to “implementing the ... bias and modulation at different times.” *First Office Action at 2, (emphasis added)*. Therefore, the Examiner’s contention in the second Office Action that claims 6-9 were not characterized as implementing the bias and modulation at different times is incorrect because the Examiner clearly stated otherwise in the first Office Action. As a result, this contradictory characterization of claims 6-9 only reinforces that claims 6 and 8 are not mutually exclusive from claims 7 and 9, thereby again establishing the impropriety of the Examiner’s restriction requirement.

Therefore, for at least the foregoing reasons, Applicant respectfully submits that the restriction requirement set forth by the Examiner is improper. Accordingly, Applicant respectfully requests that the Director reconsider such restriction requirement and ultimately withdraw the initial restriction requirement. Alternatively and at the very least, Applicant

respectfully requests that the Director issue a new restriction requirement encompassing two new species, namely Species IA (claims 1, 2, 4-9, and 15-22) and Species IIA (claims 1 and 3).

**CONCLUSION**

In conclusion, an action on the merits of this Petition to Review a Restriction Requirement is respectfully requested. In the event that the Examiner or the Director wishes to discuss any of the matters contemplated hereby, both are invited to initiate a telephone conversation with the undersigned.

Dated this 26<sup>th</sup> day of June, 2007.

Respectfully submitted,

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